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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/710,788	08/03/2004	Alexander Stoll	81101893/FMC 1770 PUS	4787
28395	7590	12/01/2005	EXAMINER	
BROOKS KUSHMAN P.C./FGTL 1000 TOWN CENTER 22ND FLOOR SOUTHFIELD, MI 48075-1238			ROSS, DANA	
			ART UNIT	PAPER NUMBER
			3722	

DATE MAILED: 12/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/710,788

Applicant(s)

STOLL ET AL.

Examiner

Dana Ross

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/3/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Examiner notes that there are four disclosed embodiments in Applicant's disclosure. However, due to the number of 35 USC 112 issues, it is not clear which claims read on the various embodiments, or if they read on a single disclosed embodiment. For the purpose of this examination, the claims will be examined as generic claims directed towards the broad embodiment of Figure 1. Examiner notes that with the resolution of the 35 USC 112 issues, and any amended claim language or new claims, a restriction requirement may be required in the next office action. Examiner recommends Applicant choose one embodiment and direct the claims clearly and precisely towards that invention.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 1-20, it is not clear what is being claimed by the terminology of "the conduit". The disclosure and drawings reference number 32 for the conduit. However, a conduit is generally defined in the art as a passage or pipe through which wires or water flows. Claim 1 has a tool holder with a body portion "at least partially disposed in the conduit". This seems to mean

that the conduit is an opening. Claim 3 further limits claim 1 by placing a spring between the flange portion of the tool holder and the conduit. It is not clear if this limitation places the spring inside the conduit or any place outside of the conduit nearest the flange portion. Applicant is also referred to claims 11 and 17, .

Claims 1-20, it is not clear what is being claimed by the limitation of the “locating member”. It appears this is the “adjusting member” (16) disclosed in the disclosure, however since there is no reference to a “locating member”, it is not clear what is being claimed.

Claims 7 and 14, it is not clear how the second section (54) of the connection tube (50) is at least partially disposed “in the internal fluid passage” (44). It appears the second section (54) actually surrounds the connection tube (50) second section (54) (see Applicant’s drawings figures 1-4).

Claims 11 and 12, it is not clear how the connection tube 50 is integrally formed with the location member 16 (if this is the disclosed adjustment member) and how the invention works with the two being integral. It furthermore is not clear what purpose the spring provides (claim 12) for an integral connection tube 50 with the location member 16, since the location member is made of the body portion 40, flange portion 42 of claim 11. It is not clear how the spring can bias the locating member to engage the end surface 24 with there being no movement of the spring due to the claimed structure.

The above is a sampling of the 35 USC 112 1st paragraph issues. Applicant is required to review all claims to ensure compliance with 35 USC 112.

Claim Rejections - 35 USC § 102

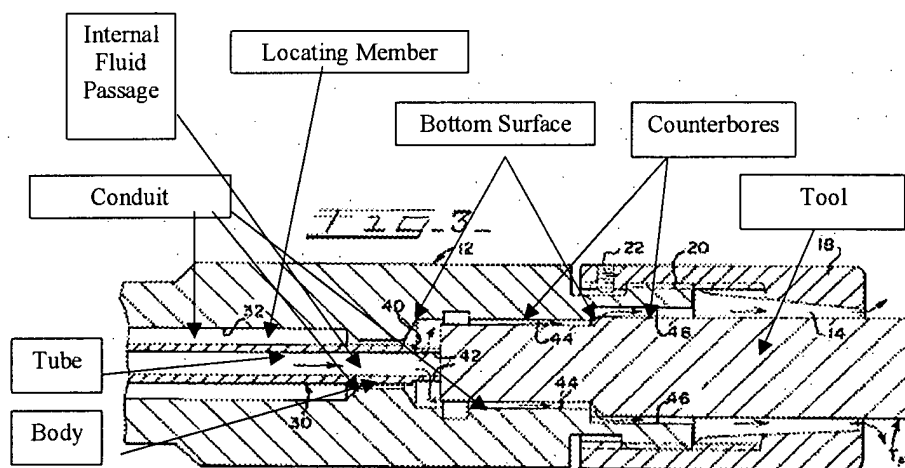
4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 4, 5, 7, 8, 9, 11-15, 18 and 19, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 4,640,652 (Rivera, Jr., hereafter '652).

'652 teaches a tool holder for coolant deliver with a plurality of bores and a bottom surface, a conduit with first and second diameters and internal fluid passage (see figure 3 below) and spring 34 (see figure 2); the connection tube with a section with a smaller outside diameter than another section of the tube (see figure 3 below) with the inside of the tube engaging with the internal fluid passage. It is noted that '652 teaches a chamfer on a flange portion (see figure 1, for example).



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6. Claims 1-9, 11-20, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 4,591,300 (Weiblen et al., hereafter '300).

'300 teaches a tool holder with a counter bore 25 adapted to receive a cutting tool and has a bottom surface (see figure 1, for example); a conduit axially aligned with the counter bore (see area near reference number 23 of figure 1); a locating member (see area of reference number 15 or 26 of figure 1) with a body portion at least partially disposed in the conduit; a flange portion disposed in the counter bore adjacent to the body portion (see figure 1 near reference number 26); internal fluid passage (see reference number 9 of figure 1) defined by the body and the flange portions; spring 28 which biases the locating member (see figure 1), the spring being located between the flange and the bottom surface, the flange and the conduit, the flange and the connection tube; the flange and the bottom surface, and the flange and the engagement surface. It is noted that '300 teaches a chamfer on a flange portion (see figure 1, for example).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2-3, 6, 10, 16, 17 and 20 rejected under 35 U.S.C. 103(a) as being unpatentable over '652 and '300.

Both '652 and '300 teach all aspects of the independent claims.

Regarding the location of the spring (claims 2, 3, 6, 16, 17 and 20), both '652 and '300 teach the use of a spring for biasing.

Applicant has claimed the spring being located between the flange and the bottom surface, the flange and the conduit, the flange and the connection tube, the flange and the bottom surface, and the flange and the engagement surface. At the time the invention was made, it would have been an obvious matter of design choice to one of ordinary skill to place the spring wherever was most efficient and economical based on the machine tools available and the type of machining to be performed because Applicant has not disclose that any particular location of the spring provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the spring arrangement as taught by either '652 or '300 since the purpose of the spring is to provide a biasing force on the workpiece with the fluid passages.

Regarding the location of the seal (claim 10), it is noted that '652 (col. 5, lines 3-28, for example) and '300 (see col. 4, lines 21-35, for example) both address the aspect of requiring seals. Examiner notes that it is notoriously well known in the machine tool art to use seals to prevent the leakage of fluid. At the time the invention was made, it would have been an obvious matter of design choice to one of ordinary skill to place the seal wherever was most efficient and economical based on the machine tools available and the type of machining to be performed because Applicant has not disclose that any particular location of the seal provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the seal arrangement as taught by either '652 or '300 since the purpose of the seal is to prevent leakage.

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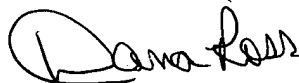
Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dana Ross whose telephone number is 571-272-4480. The examiner can normally be reached on Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Dana Ross
Examiner
Art Unit 3722



dmr